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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 2839
Attorney Docket No. 13457

In re
Patent Application of:

Turek et al.

Serial No.: 10/092,078

Filed: March 6, 2002

Examiner: Dinh, Phuong K

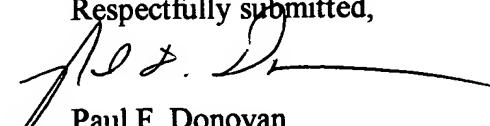
**“ELECTRICAL COMPONENT
TERMINAL CONNECTOR”**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Response to a Second Restriction Requirement in the above-identified application. No extension of time in which to respond to the outstanding Office Action is believed due. However, if an extension of time to respond is required, please consider this a petition therefore and charge any additional fees which may be required as set forth below. Please debit any deficiency or credit any overpayment to Deposit Account No. 09-0025 as may be required in connection with the submission of this Response and associated documents. IN NO EVENT CAN THE ISSUE FEE BE CHARGED TO THE DEPOSIT ACCOUNT.

Respectfully submitted,


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**"ELECTRICAL COMPONENT
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I, Paul F. Donovan, hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Paul F. Don

June 30, 2004

Date of Signature

RESPONSE TO SECOND RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication responds to the Office Action mailed June 15, 2004.

The Examiner has identified in the application two groups of claims and has required restriction to one of these groups. The groups are Group I (claims 1-11) drawn to a connector for connecting an associated electrical component and Group II (claims 12-22) drawn to a connector and carrier and method of making the combination. Applicants' attorney elects to prosecute the claims of Group I with traverse, as further set forth below, and respectfully requests reconsideration of the restriction requirement.

The subject application was filed on March 6, 2002 with 22 claims, of which claims 1, 12 and 18 were independent. Claims 1 and 12 were directed to a connector for connecting an associated electrical component having a tab-type electrical terminal to an associated conductor. Claim 18 was directed to a method for making a connector for connecting an associated electrical component having a tab-type electrical terminal to an associated conductor.

On May 21, 2003 the Office mailed a restriction / election requirement in regards to the subject application. Examiner Son Nguyen under supervisor Lynn Feild identified in the application two groups of claims and required restriction to one of these groups. The groups were Group I (claims 18-22) drawn to a method of making a connector and Group II (claims 1-17) drawn to an electrical connector. In a Response mailed June 20, 2003, Applicants' elected to prosecute the claims of Group II with traverse. In the same Office Action of May 21, 2003, Examiner Nguyen indicated that each Group I and II contained claims directed to patentably distinct species. In response, the Applicants' elected, with traverse, for prosecution on the merits the embodiment of the claimed invention illustrated in FIGURES 1-5 showing a connector with a cover.

In the next Office Action dated September 2, 2003, Examiner Nguyen, under the supervision of Lynn Feild, granted the Applicants request for reconsideration of the election / restriction requirement of the last Office Action and, therefore, the election / restriction requirement was withdrawn. Examiner Nguyen then proceeded to examine claims 1-22 on their merit.

In response to the Office Action of September 2, 2003, the Applicants filed an amendment on December 1, 2003. Claims 10-11 and 16-17 were cancelled. Claims 1 and 12 were amended. However, the subject matter of claims 1, 12 and 18 was not changed. In other words, claims 1 and 12 remained directed to a connector for connecting an associated electrical component having a tab-type electrical terminal to an associated conductor, and claim 18 remained directed to a method for making a connector for connecting an associated electrical component having a tab-type electrical terminal to an associated conductor.

On February 26, 2004, Examiner Nguyen, again under the supervision of Lynn Feild, issued another Office Action. In this Office Action, the Examiner indicated that

claims 1-22 would be allowable if simply rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph.

On March 24, 2004, the Applicants submitted an Amendment addressing the 112 rejections and put all of the pending claims (i.e., 1-9, 12-15 and 18-22) in condition for allowance.

The Applicants were expecting a Notice of Allowance in response to the Amendment filed on March 24, 2004, not another restriction / election requirement. The undersigned notes that a new Examiner, Examiner Phuong Dinh, issued the Office Action dated June 15, 2004. However, interestingly, Examiner Feild is still the supervisor for this application.

MPEP 811 states that an Examiner should make a proper restriction requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. MPEP 811.03 indicates that where a requirement to restrict is made and withdrawn, because it was improper, when it becomes proper at a later stage in the prosecution, restriction may again be required. However, this assumes the subject matter of a claim changes during prosecution (e.g., from a product to perhaps a product by process claim). In the subject application, the previous Examiner, under supervisor Lynn Field, issued a restriction requirement that was later withdrawn because of arguments made by the Applicants. As set forth above, the subject matter of independent claims 1, 12 and 18 has not changed since the application was originally filed. Thus, there has been no changes to the claims to now indicate that the previously improper restriction is now proper. It is respectfully argued that had the previous Examiner and supervisor Feild wanted to issue the current restriction requirement, they should have done so much earlier during the prosecution of the subject application. After all, MPEP 815 states that when making a restriction requirement, every effort should be made to have the requirement complete. To now require the Applicants to restrict the application for examination purposes seems patently unfair and unduly burdensome, especially since substantive prosecution of the claims has already taken place, and even more importantly, since the claims are currently in condition for allowance.

Another argument that the current restriction requirement is improper or, at the very least, unfair stems from the provisions of MPEP 818.01. In this section, the MPEP states that election becomes fixed when claims in an application have received an action on their merits by the Office. Although this presumably applies to an election made by an applicant, it seems the same rules should apply to the Office. Thus, since the scope of the claims has not changed, since the Office previously withdrew its original improper election requirement, and since all of the claims have received an action on their merits, it does not seem fair that the Office should issue another requirement under these circumstances.

Moreover, even if the subject application includes independent and distinct invention, MPEP 803 sets forth that if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions. Since the entire application has already been searched and examined, the Examiner should not now be allowed to require the application to be divided in two. If Examiner Dinh wants to perform an additional search, it is respectfully argued, in the interest of fairness, that having Examiner Dinh search and examine the entire application would not present a serious burden to Examiner Dinh, especially since the previous Examiner and supervisor Field already performed a search and examined the entire application at once.

In conclusion, it is understood that a restriction requirement is intended to facilitate the Examiner's initial search in the examination of the application. However, as argued above, the application has already undergone substantive examination and the subject matter of the claims has not changed since the original filing of the application.

The inventions of Groups I and II are so inextricably related to one another that they should be examined in a single application. Practicality and efficiency and a lack of serious burden on the Examiner dictate that the claims should be retained in a single application and the restriction requirement should be withdrawn. The restriction requirement, if sustained, will prejudice the applicants because of the increased cost to applicants arising from further substantial filing fees and prosecution costs. This is especially true given that substantive prosecution of all of the claims has already taken place.

In view of the foregoing, withdrawal of the restriction requirement is respectfully requested.

Respectfully Submitted,

Date: June 30, 2004

By:


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